

REMARKS

This responds to the Office Action mailed on February 14, 2006, and the references cited therewith.

Claims 1, 6, 8, 9, 21, 24, 25, 27, 28, 31, 33, 35 and 48 are amended; no claims were cancelled; as a result, claims 1-48 remain pending in this application.

Claim Objections

Claims 22 and 25 were objected to because a claim, which depends from a dependent claim, should not be separated by any claim which does not also depend from said dependent claim. Claims 21, 24 and 25 have been amended to address the objection. It is submitted that the objection has been overcome.

§103 Rejection of the Claims

Claims 1-3, 7, 9-17, 19-29, 32, 34-41, 43-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. (U.S. 2002/0049617) in view of Wolff et al. (U.S. 2002/0029158).

Claims 4-6, 18, 30, 31, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. and Wolff et al. as applied to claims 1 and 28 above, and further in view of Marchosky (U.S. 2002/0029157).

Claims 8 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. and Wolff et al. as applied to claims 1 and 28 above, and further in view of Peach (U.S. 2001/0049611).

Response to the §103 Rejections of the Claims

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The basis for the amendments to the claim can be found in the specification, e.g., at paragraphs 42 and 49.

The combination of Lencki and Wolff is improper because of lack of suggestion or motivation to combine these references

The combination of Lencki and Wolff is improper because there is no suggestion or motivation to combine these references. The combination is suggested by the invention of claim 1, i.e., impermissible hindsight has been used to combine the references.

To determine whether the combination of Lencki and Wolff is proper, the source of the suggestion or motivation to combine the references must be established. If the suggestion or motivation to combine Lencki and Wolff is dictated solely by the invention of claim 1, such combination is improper. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office action states that the motivation to combine the teachings Lencki and Wolff would have been to create [an] Insurability Documentation File that contains information needed by insurers to evaluate a prospective insured party. It is submitted that while Wolff discloses an Insurability Documentation File (Wolff, Abstract), there is nothing in Lencki that indicates that such Insurability Documentation File would be useful in the context of Lencki, where the insurance benefit is being offered by an employer to the employees.

The Office action further states that the motivation to combine the teachings of Lencki and Wolff would have been to enable bidding by different insurers to increase the likelihood of the prospective insured finding an insurance policy that fits his or her needs. It is submitted that while Wolff discloses insurers providing bids based on Insurability Documentation File for a particular prospective insured party (Wolff, Abstract), such bidding mechanism would not be

applicable to employer/employee context of Lencki, where the employee is permitted to select from both upgraded and supplemental benefits from discreet line items (Lencki [0082]).

Thus, the motivation to combine Lencki with Wolff is suggested solely by hindsight in view of the present “method for processing health insurance applications over a network, the method comprising: presenting a user interface to an applicant over the network, the user interface including information pertaining to a health insurance plan selected by the applicant and facilitating input of application data by the applicant; receiving the application data from the applicant via the network; obtaining an electronic signature from the applicant; obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature; transforming the application data into a secure digital file thereby creating a finalized health insurance application; and transmitting the secure digital file to the health insurance carrier.”

The U.S. Court of Appeals for the Federal Circuit specifically indicated that when an obviousness rejection is made, an examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would invoke the use of such elements in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Thus, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Id.* Because no showing of motivation to combine can be found in either Lencki or Wolff, such combination is improper.

Lencki and Wolff disclosures teach away from the method of claim 1

The present invention is focused on improving the process for searching for and applying for health insurance by teaching a method to apply for health insurance online without the assistance of a health insurance agent or broker. The method of claim 1 teaches a process by which general consumers can complete a health insurance application online, signal their commitment to be bound by the terms of the application, and submit the application to a health insurance carrier. That application is a finalized health insurance application and is thus a legally binding contract between the applicant and the insurer.

In contrast, Lencki is focused on improving employer and consumer satisfaction, while confronting the rising costs of employee benefit offerings (Lencki [0078]). Lencki is directed at offering the line items within a benefit category for purchase by the individual (Lencki, Abstract). Specifically, Lencki teaches the employer determining the minimum benefit package for the company, i.e. health, dental, life, 401(K) etc, and the employee selecting from both upgraded and supplemental benefits from discreet line items, e.g., via an on-line mechanism (Lencki [0082]). Thus, because in Lencki an on-line activity of an employee is related merely to supplemental benefits from discreet line items in conjunction with the minimum benefit package predetermined by the employer, Lencki teaches away from “presenting a user interface to an applicant over the network, the user interface including information pertaining to a health insurance plan selected by the applicant and facilitating input of application data by the applicant “ and “creating a finalized health insurance application,” as recited in claim 1. In other words, Lencki merely describes a process of choosing supplemental benefits within an employer sponsored health plan; it does not predict, suggest or contemplate a process for general consumers to complete and create a finalized health insurance application (e.g., where consumers are contractually bound by a health insurance application).

Wolff, on the other hand, is directed at creating an Insurability Documentation File that contains the information needed by underwriters or insurers to evaluate the insurability rating of the prospective insured party (Wolff, Abstract). An Insurability Documentation File, while including secure information, can by no means be regarded as a health insurance application. Rather, it is merely the data used by insurance carriers to evaluate the insurability rating of the prospective insured party. Treating an Insurability Documentation File as a health insurance application would defeat the purpose of soliciting bids from insurers, which is the stated purpose of Wolff (Wolff, [0013]). Thus, Wolff teaches away from “obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature” and “transforming the application data into a secure digital file thereby creating a finalized health insurance application,” as recited in claim 1.

Lencki and Wolff, whether considered separately or in combination, fail to disclose or suggest each and every element of claims 1-48

Even if Lencki and Wolff were combined, Lencki and Wolff, whether considered separately or in combination, fail to disclose or suggest each and every element of claim 1.

The Office action correctly stated that Lencki fails to teach assembly of user information into a single secure document for transmission to insurance carriers. The Office action combines Lencki with Wolff in an attempt to show this feature. Specifically, the Office action refers to an Insurability Documentation File disclosed in Wolff at [0015-0018]. As discussed above, an Insurability Documentation File, while including secure information is merely used by insurance carriers to evaluate the insurability rating of the prospective insured party. Thus, neither Lencki nor Wolff nor a combination thereof discloses or suggests “**creating a finalized health insurance application** by transforming the application data obtained from an applicant into a secure digital file,” as recited in claim 1, as amended.

Furthermore, neither Lencki nor Wolff nor a combination thereof discloses or suggests obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature, as recited in claim 1, as amended. This is non-sensical in the case of Wolff that describes a bidding system where an insurance agent or wholesaler is provided with an efficient ability to solicit insurability rating bids from a substantial number of insurance carriers. (Wolff, [0013]).

Therefore, because not every element of claim 1 is disclosed by the combination of Lencki and Wolff, claim 1 and its dependent claims are patentable in view of the Lencki and Wolff combination and should be allowed.

Claim 27 recites “a transaction facility coupled to plurality of client devices to receive client data from the client devices, obtain an electronic signature from the applicant, obtain a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature, and transform the client data into a secure digital file thereby creating a finalized health insurance application.” Therefore, claim 27 is patentable in view of the Lencki and Wolff combination for at least the reasons articulated with respect to claim 1.

Claim 28 recites “an electronic presenter to present a user interface . . . , the user interface . . . facilitating input of application data, an electronic signature, and a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature by the applicant” and “an application data processor to transform the application data into a secure digital file thereby creating a finalized health insurance application.” Therefore, claim 28 and its dependent claims are patentable in view of the Lencki and Wolff combination for at least the reasons articulated with respect to claim 1.

Claim 48 recites “obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature” and “transforming the application data into a secure digital file thereby creating a finalized health insurance application.” Therefore, claim 48 is patentable in view of the Lencki and Wolff combination for at least the reasons articulated with respect to claim 1.

Lencki, Wolff, and Marchosky, whether considered separately or in combination, fail to disclose or suggest each and every element of claims 4-6, 18, 30, 31, and 42

Claims 4-6, 18, 30, 31, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. and Wolff et al. as applied to claims 1 and 28 above, and further in view of Marchosky (U.S. 2002/0029157). Marchosky is directed at a system and process for providing a computerized medical and biographical records database and diagnostic information (Marchosky, Abstract).

Claims 4-6 and 18 include the features of “obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature” and “transforming the application data into a secure digital file thereby creating a finalized health insurance application” by virtue of its being dependent on claim 1. Claims 30, 31, and 42 include the features of “an electronic presenter to present a user interface . . . , the user interface . . . facilitating input of application data, an electronic signature, and a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature by the applicant” and “an application data processor to transform the application data into a secure digital file thereby creating a finalized health insurance application” by virtue of its being dependent on claim 28.

Marchosky, whether considered separately or in combination with Lencki and Wolff, fails to disclose or suggest these features. In other words, a database of biographical information does not contemplate a process for creating a finalized health insurance application online. Thus, claims 4-6, 18, 30, 31, and 42 are patentable in view of the Lencki, Wolff and Marchosky combination and should be allowed.

Lencki, Wolff, and Peach whether considered separately, or in combination, fail to disclose or suggest each and every element of claims 8 and 33

Claims 8 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. and Wolff et al. as applied to claims 1 and 28 above, and further in view of Peach (U.S. 2001/0049611). Peach is directed at Electronically acquiring and distributing insurance policy data to agent offices (Peach, Title).

Claim 8 includes the features of “obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature” and “transforming the application data into a secure digital file thereby creating a finalized health insurance application” by virtue of its being dependent on claim 1. Claim 33 includes the features of “an electronic presenter to present a user interface ..., the user interface ... facilitating input of application data, an electronic signature, and a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature by the applicant” and “an application data processor to transform the application data into a secure digital file thereby creating a finalized health insurance application” by virtue of its being dependent on claim 28. Peach, whether considered separately or in combination with Lencki and Wolff, fails to disclose or suggest these features. In fact, it should be readily discernible that among the many distinctions between the present invention as claimed and Peach is this: Peach is directed towards facilitating the sharing of information within an insurance agency, between agents; the present invention as claimed is directed at consumers to complete a health insurance application without the assistance of such an agent. Thus, claims 8 and 33 are patentable in view of the Lencki Wolff and Peach combination and should be allowed.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4041 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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